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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,987	12/21/2001	Gerald Delgorgue	P21689	8136
7055	7590	10/03/2003	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			PATTERSON, MARIE D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 10/03/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/023,987

Applicant(s)

DELGORGUE ET AL.

Examiner

Marie Patterson

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Claim Rejections - 35 USC § 112

1. Claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 8 the phrase "the outer heel reinforcement" lacks antecedent basis rendering the claim vague and indefinite.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 6, 29-31, 33, 34, and 38-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Cagliari (5732483).

Cagliari shows a boot comprising a sole (4), an upper (2) which is made of thermoplastic material which is considered to be "impervious", an outer reinforcing element (3) which has flaps (6-11) and a collar (formed by 12 and 13) and which is cemented (adhesively bonded, column 3 line 1 and column 4 lines 15-25) to the upper as claimed.

4. Claims 1, 2, 7-9, 15, 17, 19, 22, 24, 27, 28, 29, 30, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferrettie (2306306).

Ferrettie shows a boot comprising a sole (17), an upper (11) which is made of leather which is considered to be "impervious", an outer reinforcing element (19, which

has a heel portion with lateral flaps extending therefrom, i.e. sides), an outer seam in the upper (22 and/or formed at heel by attachment of the stiffener element 13, shown in figure 2) which is covered by cementing the reinforcing element over the seam (see page 2 column 1 lines 60-65) as claimed.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6, 11-16, 21, 29-34, and 38-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cagliari in view of Griffin (5678329).

Cagliari shows a shoe comprising an upper (2) with a reinforcing element (3) cemented thereon and a sole portion (4) substantially as claimed except for a distinct sole portion which is separate from the reinforcing element. Griffin teaches providing a separate/distinct sole (26) from a reinforcing element (27) as an alternative to both elements being formed integral (see column 2 lines 34-43). It would have been obvious to provide a distinct sole as taught by Griffin as an alternative to the integrally formed sole in the shoe of Cagliari to increase the durability of the shoe by providing a more durable material for the outsole portion.

In reference to claims 16, 21, and 32, the use of waterproof coatings, seal coating, and other types of coatings on uppers of footwear are well known and conventional in

the footwear art. It would have been obvious to provide a coating on the upper as is well known and conventional in the art of footwear to protect the upper from damage.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrettie in view of either Barrett (5940990) or Donnadiou (5704138).

Ferrettie shows a boot substantially as claimed except for an inner tightening system. Barrett or Donnadiou teaches providing an inner tightening system (10 or 8). It would have been obvious to provide an inner tightening system as taught by either Barrett or Donnadiou in the boot of Ferrettie to increase support of the foot.

8. Claims 18, 23, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrettie.

Ferrettie shows a shoe substantially as claimed except for a coating on the upper. The use of waterproof coatings, seal coating, and other types of coatings on uppers of footwear are well known and conventional in the footwear art. It would have been obvious to provide a coating on the upper as is well known and conventional in the art of footwear to protect the upper from damage.

9. Claims 3-9, 12-14, 20, 25, 26, 31, and 33-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrettie in view of Cagliari or Griffin (5678329).

Ferrettie shows a shoe substantially as claimed except for the exact shape of the reinforcing element and closure/tightening means for the shoe. Cagliari or Griffin teaches providing flaps as part of a reinforcing element which form the tightening means in a shoe. It would have been obvious to provide flaps and tightening structure as

Art Unit: 3728

taught by either Cagliari or Griffin in the shoe of Ferrettie to increase support and fit of the shoe.

In reference to claim 26 and 42, Cagliari teaches providing a detachable liner (29). It would have been obvious to provide a detachable liner in the shoe of Ferrettie as modified above to increase comfort and fit.

10. Claims 11 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 further in view of Tomaro (5499459).

Cagliari or Ferrettie as modified above shows a boot with a detachable liner (29) substantially as claimed except for the exact liner having a shock absorbing sole. Tomaro teaches forming a detachable liner (12) with a shock absorbing sole (14, layer 32, see column 2 lines 60-65). It would have been obvious to use the detachable liner of Tomaro for the liner in the boot of Cagliari or Ferrettie as modified above to increase comfort, insulation, etc..

Response to Arguments

11. Applicant's arguments filed 8/21/03 have been fully considered but they are not persuasive.

In reference to applicants' arguments directed towards Cagliari, these arguments are either moot in view of the new rejection above, or the argued elements are not claimed in claims 6, 29-31, 33, 34, and 38-42. In reference to claim 6, the lace and flaps are considered to be the "only" tightening means inasmuch as such a limitation is broadly understood.

Art Unit: 3728

In response to Applicant's argument that the prior art does not include certain features of Applicant's invention, the limitations on which the Applicant relies (i.e., upper which is impervious to water and the arguments relating to claim 7 are confusing and not understood) are not stated in the claims. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable.

Constant v. Advanced Micro-Devices Inc., 7 USPQ2d 1064.

12. Applicant's arguments with respect to claims 1-43 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3728

1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9302. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner ____ of Art Unit ____ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.



Marie Patterson
Primary Examiner
Art Unit 3728